

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re PATENT APPLICATION

HORII et al.

Application No.: 09/398,366

Filed: September 17, 1999

Title: OPTICAL IMAGING APPARATUS



Group Art Unit: 2877

Examiner: Unknown

Atty. Dkt. 41050/264018

* * * *

January 17, 2002

PETITION FOR RETROACTIVE LICENSE

Hon. Commissioner of Patents
Washington, D. C. 20231

Sir:

This petition for a retroactive license under 35 USC 184 and 37 CFR 5.25 is presented
in accordance with 37 CFR 5.14(a).

1. Two unlicensed patent applications were filed by Olympus Optical Co. Ltd. in

Japan:

- a. Japanese Application No. 10-266752 filed September 21, 1998
(Olympus Dkt. No. 98P015787)
- b. Japanese Application No. 10-266753 filed September 21, 1998.
(Olympus Dkt. No. 98P015787)

2. The subject matter in each of those Japanese applications was not under a U.S.
secrecy order at the time it was filed in Japan. It has never been and is not
currently under a secrecy order in the United States.

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3. Discovery that the foreign filings were proscribed occurred on or about February 17, 1999 when an Olympus trainee, Kazutaka Kobayashi, asked me whether a foreign filing license was necessary , and I said yes.
4. The two applications were filed in Japan without first having obtained the required license under 37 CFR 5.11 because the persons involved in their filing did not know either that (1) subject matter disclosed in either application was invented in the United States, or (2) that before filing in Japan a patent application containing subject matter invented in the United States but not filed in the United States or on file in the United States for less than six months required a foreign filing license from the United States Government. See the enclosed Declaration of Horii et al. and the Declaration of Jiro Narita.
5. The enclosed Declaration of Mamoru Kaneko including its exhibits I through VIII sets forth the sequence of events that occurred up through the sending of both disclosures to the outside patent firm, Itoh-shin Patent Office, to prepare and file two patent applications in the Japanese Patent Office.
6. The person in the Itoh-shin Patent Office who prepared and filed the two Japanese applications was Jiro Narita. See his enclosed Declaration as to his knowledge and procedure.
7. The required Rule 17(h) petition fee of \$130 (fee code 122) is attached. Should it be missing or inadequate, please charge our Deposition Account No. 03-3975 under Order No. 60148/258937.
8. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false

statements and the like so made are punishable by fine or imprisonment, or both,
under Section 1001 of Title 18 of the United States Code and that such willful
false statements may jeopardize the validity of the application or any patent issued
thereon.

Approval of this petition is earnestly solicited.

Respectfully submitted,

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